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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/824,154

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Wendy Hufford

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BUCKLEY, MASCHOFF & TALWALKAR LLC
50 LOCUST AVENUE
NEW CANAAN, CT 06840

EXAMINER

PASS, NATALIE

ART UNIT

PAPER NUMBER

3686

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/824,154	HUFFORD ET AL.	
	Examiner	Art Unit	
	Natalie A. Pass	3686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>14 April 2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the application filed 14 April 2004. Claims 1-28 are pending. The Information Disclosure Statement filed 14 April 2004 has been entered and considered.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. § 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 13-28 are rejected under 35 U.S.C. §101.

A) As per claims 13-28, these appear to be directed toward a method or process of operating a computer system. Based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim

should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

In the instant application, although independent claims 13, 21, and 24 recite a method of operating a computer system, including navigating and displaying within the system, Applicant's method steps fail the first prong of the new Federal Circuit decision, since navigating and displaying on a computer system provide only a nominal recitation of a computer as a venue on which the method steps are performed and amount to nominal or token recitations of structure. Courts have decided that "nominal or token recitations of structure in a claim do not convert an otherwise ineligible claim into an eligible one. See e.g., *Comiskey*, 499 F.3d at 1380 ("the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter") (citing *In re Grams*, 888 F.2d 835, 839-40 (Fed. Cir. 1989))." (Also see *Benson*, 409 U.S. at 71-72).

Furthermore, the method steps fail to unambiguously require transformation of underlying subject matter to a different state or thing. The mere manipulation and production of non-functional descriptive material (i.e., a "notification of a potential legal issue") is not a transformation because a notification is not statutory subject matter. Dependent claims 14-20, 22-23, 25-28 merely add further details of the methods recited in claims 13, 21, and 24 without including any tie to another statutory category or any transformation of subject matter into a different state or thing. Thus, claims 13-28 are non-statutory since they are not requisitely tied to

another statutory class and they do not requisitely transform underlying subject matter to a different state or thing.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 13-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) Claim 13 recites the limitations

- "publishing the notification of the potential legal issue " in lines 9-10; and
- "the respective potential recipient who corresponds to a one of the plurality of options selected by the first user in completing said first form" in lines 13-14.

Examiner submits that there has been neither notification completed nor selecting of options done. There is insufficient antecedent basis for these limitations in the claim.

B) Claim 21 recites the limitations

- "publishing the notification of a potential legal issue" in line 9;
- "publishing the notification" and "storing the notification" in line 11;
- "the second user" in lines 12, 13, 14; and

- "the web page associated with the second user" in lines 13-14.

Examiner submits that there has been neither notification completed nor selecting of options done. There is insufficient antecedent basis for these limitations in the claim.

C) Claim 23 recites the limitations

- "said first and second users" in line 5.

There is insufficient antecedent basis for these limitations in the claim.

D) Claim 24 recites the limitations

- "displayed from time to time" in line 21.

It is unclear how often or when these items are displayed.

E) Claim 26 recites the limitations

- "said first options selected by a user" in lines 13-14.

Examiner submits that there has been no selecting of options done. There is insufficient antecedent basis for these limitations in the claim.

F) Claims 14-20, 22-23, 25-28 incorporate the features of independent claims 13, 21 and 24, through dependency, and are also rejected.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 3-4, 6, 8, 11, 13-15, 19-21, 24, 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Burchetta, et al, U.S. Patent Number 6, 330, 551.

(A) As per claim 13, Burchetta teaches a method of operating a computer system, the method comprising :

navigating from a first screen display to a second screen display, said second screen display including a first form that is completable by a first user of the computer system to provide a notification of a potential legal issue (Burchetta; column 7, lines 20-50, column 10, lines 36-42, column 11, lines 14-16), the first form including a first menu that is actuatable by a pointing device to select among a plurality of options presented by the first menu (Burchetta; column 10, lines 36-42), each of the plurality of options corresponding to a respective potential recipient of the notification of the potential legal issue (Burchetta; Abstract, column 10, lines 36-42, column 16, lines 19-42, column 17, lines 23-27);

publishing the notification of the potential legal issue to at least one other user of the computer system (Burchetta; column 18, line 66 to column 19, line7);

in response to publishing the notification, automatically sending an electronic mail message to a second user of the computer system, the second user being the respective potential recipient who corresponds to a one of the plurality of options selected by the first user in completing said first form (Burchetta; column 7, lines 46-50, column 9, lines 16-19).

(B) As per claims 14-15, 19-20, Burchetta teaches a method as analyzed and disclosed in claim 13-15 above, further comprising:

the second user accessing the published notification (Burchetta; column 6, lines 27-36, column 14, lines 19-21);

the second user navigating to a third screen display from one of a fourth screen display and the first screen display, the third screen display including a second form that is completeable by the second user to provide a response to the published notification (Burchetta; column 14, lines 25-56, column 15, lines 45-47);

the second user using the second form to indicate reassignment of the published notification to a third user (Burchetta; column 6, lines 49-55); and

in response to publishing the notification, storing the notification at a web page associated with the second user; and wherein the second user accessing the published notification includes the second user accessing the web page associated with the second user (Burchetta; column 16, lines 36-41, column 17, lines 23-27, column 18, line 65 to column 19, line 2).

(C) As per claim 21, Burchetta teaches a method of operating a computer system, the method comprising :

navigating from a first screen display to a second screen display, said second screen display including a first form that is completeable by a first user of the computer system to provide a notification of a potential legal issue (Burchetta; column 7, lines 20-50, column 10, lines 36-42, column 11, lines 14-16), the first form including a first menu that is actuatable by a

pointing device to select among a plurality of options presented by the first menu (Burchetta; column 10, lines 36-42), each of the plurality of options corresponding to a respective potential recipient of the notification of the potential legal issue (Burchetta; Abstract, column 10, lines 36-42, column 16, lines 19-42, column 17, lines 23-27);

publishing the notification of a potential legal issue to at least one other user of the computer system (Burchetta; column 18, line 66 to column 19, line 7);

in response to publishing the notification, storing the notification at a web page associated with the second user; and the second user accessing the web page associated with the second user to access the published notification (Burchetta; column 16, lines 36-41, column 17, lines 23-27, column 18, line 65 to column 19, line 2).

(D) As per claim 24, Burchetta teaches a method of operating a computer system, the method comprising :

(a) displaying on at least one display device of the computer system a welcome screen display that includes a confidentiality and privilege notice and which provides an overview of an early warning system for potential legal issues (Burchetta; Figure 2, Item 21, Figure 3, Items 30-31, column 8, lines 1-14);

(b) displaying on at least one display device of the computer system a potential issues room screen display that allows a user access to other screen displays which provide information concerning potential legal issues (Burchetta; Figure 2, column 15, lines 23-47);

(c) displaying on at least one display device of the computer system a request folder screen display that lists at least one notification of a potential legal issue (Burchetta; column 16, lines 20-30)

(d) displaying on at least one display device of the computer system a request form screen display that is completeable by using at least one of a keyboard and a pointing device to publish a notification of a potential legal issue (Burchetta; column 18, line 66 to column 19, line7);

(e) displaying a plurality of subject area room screen displays, each corresponding to a respective area of responsibility within a corporation that operates the computer system and each displaying at least one line of information concerning a potential legal issue related to the respective area of responsibility, each of the plurality of subject area room screen displays being displayed from time to time on at least a respective display device of the computer system (Burchetta; column 12, lines 17-25, column 16, lines 19-30);

(f) displaying on at least one display device of the computer system a response folder screen display that lists at least one response to a notification of a potential legal issue (Burchetta; column 12, lines 17-25, column 16, lines 19-30); and

(g) displaying on at least one display device of the computer system a response form screen display that is completeable by using at least one of a keyboard and a pointing device to publish a response to a notification of a potential legal issue (Burchetta; column 12, lines 17-25, column 18, line 66 to column 19, line7).

(E) As per claim 27, Burchetta teaches a method as analyzed and disclosed in claim 24 above,

wherein at least some of said screen displays include a plurality of actuatable buttons arrayed in a column at a left-hand side of the respective screen display (Burchetta; column 10, lines 39-41, column 14, lines 27-29), at least some of the actuatable buttons of said column each corresponding to a respective one of the areas of responsibility (Burchetta; column 12, lines 17-25, column 16, lines 19-30).

(F) System claims 1, 3-4, 6, 8, 11 repeat the subject matter of method claims 13, 24, 14, 27, 24, 27, respectively, as a set of apparatus elements rather than a series of steps. As the underlying processes of claims 13, 24, 14, 27 have been shown to be fully disclosed by the teachings of Burchetta in the above rejections of claims 13, 24, 14, 27, it is readily apparent that the method disclosed by Burchetta includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claims 13, 24, 14, 27, and incorporated herein.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2, 5, 9, 10, 16-18, 22-23, 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burchetta et al, U.S. Patent Number 6, 330, 551 in view of Heckman et al, U.S. Patent Number 5, 875, 431.

(A) As per claim 16, Burchetta teaches a method as analyzed and disclosed in claims 13-15 above.

Burchetta fails to explicitly disclose a method further comprising: the second user entering into said second form information which identifies a business practice which is relevant to a potential legal issue that is a subject of the published notification.

However, the above features are well-known in the art, as evidenced by Heckman.

In particular, Heckman teaches a method further comprising: the second user entering into said second form information which identifies a business practice which is relevant to a potential legal issue that is a subject of the published notification (Heckman; column 13, line 34 to column 14, line 28).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Burchetta to include these limitations, as taught by Heckman, in order “to establish control over the direction of a legal matter early in the case” and to manage “litigation and other legal matters, cost control, and outcome prediction and evaluation” (Heckman; column 4, lines 50-55).

(B) As per claims 17-18, 22-23, Burchetta and Heckman teach a method as analyzed and disclosed in claims 13-16, 21 above

wherein the second form includes a second menu that is actuatable by a pointing device to select among a plurality of options that includes an early warning option to indicate that a warning notice concerning the potential legal issue is to be provided to “the parties” (reads on “a plurality of users of the computer system other than said first and second users”) (Burchetta; column 5, lines 37-39, column 9, lines 16-19, column 10, lines 36-41) (Heckman; column 7, line 21 to column 8, line 20, column 20, lines 18-47); and

further comprising: in response to publishing the notification, storing the notification at a web page associated with the second user; and wherein the second user accessing the published notification includes the second user accessing the web page associated with the second user (Burchetta; column 16, lines 36-41, column 17, lines 23-27, column 18, line 65 to column 19, line 2);

further comprising:

the second user navigating to a third screen display from one of a fourth screen display and the first screen display, the third screen display including a second form that is completeable by the second user to provide a response to the published notification (Burchetta; column 14, lines 25-56, column 15, lines 45-47); and

the second user entering into said second form information which identifies a business practice which is relevant to a potential legal issue that is a subject of the published notification (Heckman; column 13, line 34 to column 14, line 28).

The motivations for combining the respective teachings of Burchetta and Heckman are as given in the rejection of claim 16 above, and incorporated herein.

(C) As per claims 25-26, Burchetta and Heckman teach a method as analyzed and disclosed in claim 24 above, wherein:

the request form screen display includes a first drop down menu actuatable by a pointing device to display a plurality of first options each corresponding to a respective one of said areas of responsibility (Burchetta; column 12, lines 17-25, column 13, lines 15-20, column 16, lines 19-30); Examiner interprets Burchetta's teachings of various menus on assorted screens to teach a form of "a first drop down menu actuatable by a pointing device;" and

the response form screen display includes a second drop down menu actuatable by a pointing device to display a plurality of second options which include an early warning option selectable to indicate that a warning notice is to be provided to "the parties" (reads on "a plurality of users of the computer system), said warning notice identifying a potential legal issue and a business practice to which the potential legal issue is relevant (Burchetta; column 5, lines 37-39, column 9, lines 16-19, column 10, lines 36-41) (Heckman; column 7, line 21 to column 8, line 20); Examiner interprets Burchetta's teachings of various menus on assorted screens to teach a form of "a second drop down menu actuatable by a pointing device;"

further comprising: publishing a notification of a potential legal issue (Burchetta; column 18, line 66 to column 19, line 7); and in response to the publishing, automatically sending an electronic mail message to a recipient who corresponds to a one of said first options selected by a user who published said notification (Burchetta; column 7, lines 46-50, column 9, lines 16-19).

The motivations for combining the respective teachings of Burchetta and Heckman are as given in the rejection of claim 16 above, and incorporated herein.

(D) System claims 2, 5, 9, 10 repeat the subject matter of method claims 16, 25, 25, 26, respectively, as a set of apparatus elements rather than a series of steps. As the underlying processes of claims 16, 25 and 26 have been shown to be fully disclosed by the teachings of Burchetta and Heckman in the above rejections of claims 16, 25 and 26, it is readily apparent that the method disclosed by Burchetta and Heckman includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claims 16, 25 and 26, and incorporated herein.

10. Claims 7, 12, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burchetta et al, U.S. Patent Number 6, 330, 551.

(A) As per claim 28, Burchetta teaches a method as analyzed and disclosed in claim 24 and 27 above.

Although Burchetta teaches a column of actuatable buttons in various screen displays (Burchetta; column 10, lines 39-41, column 14, lines 27-29), Burchetta fails to explicitly disclose a method wherein said column of actuatable buttons is included in each one of: (i) the potential issues room screen display; (ii) the request folder screen display; and (iii) the response folder screen display.

It is the position of the Examiner that one having ordinary skill in the art at the time of the invention would have found it obvious to include said column of actuatable buttons is included in each one of: (i) the potential issues room screen display; (ii) the request folder screen

display; and (iii) the response folder screen display within the method disclosed by Burchetta, with the motivations of providing a communications linkage system to assist in resolving legal controversies “easily, effectively, and inexpensively” in which “the parties communicate only with the computer, avoiding direct communication with each other” (Burchetta; column 1, lines 32-36, column 5, lines 1-2).

(B) System claims 7, 12 repeat the subject matter of method claim 28, respectively, as a set of apparatus elements rather than a series of steps. As the underlying processes of claim 28 have been shown to be fully disclosed by the teachings of Burchetta in the above rejection of claim 28, it is readily apparent that the method disclosed by Burchetta includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claim 28, and incorporated herein.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied references Newell et al., U.S. Patent Application Publication Number 2003/0112270, Simmons, U.S. Patent Application Publication Number 20010034731, Horn et al., U.S. Patent Application Publication Number 2001/0037204, Rhoads, U.S. Patent Application Publication Number 2001/0055407, Dwyer, U.S. Patent Application Publication Number 2002/0069182, Krachman, U.S. Patent Number 6738760, Bennett et al, U.S.

Patent Number 5940800, Harlan, U.S. Patent Number 5838966, Jessen., U.S. Patent Number 7370072 teach the environment of forecasting exposure to litigation.

12. Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks
Washington D.C. 20231**

or faxed to: **(571) 273-8300.**

For informal or draft communications, please label "PROPOSED" or "DRAFT" on the front page of the communication and do NOT sign the communication.

After Final communications should be labeled "Box AF."

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/N. A. P./
Examiner, Art Unit 3686
June 7, 2009

/Gerald J. O'Connor/
Supervisory Patent Examiner
Group Art Unit 3686